

**REMARKS**

Reconsideration of the above-identified application in view of the following remarks is respectfully requested. Submitted herewith is a revised Figure 6 to correct the typographical error identified in the Office Action. Withdrawal of the objection to this Figure is requested.

A. **Status of the Claims And Explanation Of Amendments**

Claims 1-10 and 30-32 are pending. Claim 32 was rejected under 35 U.S.C. §101 as allegedly reciting non-functional description method. Claim 32 has been amended and is believed to comply with Section 101. Reconsideration is requested.

Claim 32 also was rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,094,219 to Roberts et al. (“Roberts”). Further, claims 1 and 8-10 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,170,262 to Kinoshita et al. (“Kinoshita”). Claim 30 was rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 4,927,347 to Bell (“Bell”). Claim 31 was rejected under 35 U.S.C. §102(c) as allegedly being anticipated by U.S. Patent No. 6,263,106 to Yamagata (“Yamagata”).

As to obviousness under 35 U.S.C. §103(a), claims 1-4 and 7-8 were rejected. Claims 1-2 and 7-8 were rejected as allegedly being unpatentable over U.S. Patent No. 5,806,003 to Hull et al. (“Hull”) in view of Kinoshita. Claim 3 was rejected as allegedly being unpatentable over Hull in view of Kinoshita and further in view of U.S. Patent No. 6,243,108 to Takiyama et al. (“Takiyama”). Finally, claim 4 was rejected as allegedly being unpatentable over Hull in view of Kinoshita and further in view of U.S. Patent No. 6,825,044 to Sono (“Sono”).

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Claims 5 and 6 were said to be allowable “if rewritten to overcome the rejection(s) under 35 U.S.C. §112, second paragraph, set forth in the Office Action and to include all the limitations of the base claim and any intervening claims.” Applicant is unaware of any §112 rejections pending. Accordingly, these claims are understood to be objected to but not rejected. The indication of allowable subject matter is acknowledged with appreciation.

B.     Claims 1, 8-10 And 30-32 Are Not Anticipated  
By Roberts, Kinoshita, Bell or Yamagata

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1.     Claim 32 Is Not Anticipated By U.S.  
Patent No. 6,094,219 to Roberts et al.

Applicant respectfully traverses the rejection, in paragraph 5 of the office action, that claim 32 is allegedly anticipated by Roberts. The Office Action alleges that “Roberts ‘219 discloses a computer readable recording medium (Fig. 2) in which data including a photographing mode (i.e., noted the Format/Mode as shown in Fig. 2A) of a photographing apparatus (i.e., noted the camera of Fig. 2) and a size of the image which is photographed in said photograph mode has been recorded (i.e., noted the Resolution data is a size of the image as shown in Fig. 2A; col. 5, lines 20+ of Roberts ‘219.”

Roberts discloses an electronic still camera which converts a still picture of an object or scene into an operator selectable compressed digital signal format for storage using a compression/decompression algorithm.

Claim 32 has been amended to recite “discriminating the image based on whether the size of image is large or small.” This feature is nowhere taught, disclosed or suggested in Roberts.

2. Claims 1 And 8-10 Are Not Anticipated By  
U.S. Patent No. 5,170,262 to Kinoshita et al.

Applicant also respectfully traverses the rejection, in paragraph 6 of the office action, that claims 1 and 8-10 are allegedly anticipated by Kinoshita. The Office Action indicates that Kinoshita discloses the memory control means/method and communicating means/method as claimed.

Kinoshita discloses an electronic camera electronically that records an optical image by using a non-solid-state memory in which the content of the frame memory 7 of the image pickup section 1 can be automatically and sequentially transferred at once when an image pickup section 1 and a disk recording section 2 are connected, thereby increasing the number of recording frames of the frame memory 7. *See*, col. 5, lines 39-47 of Kinoshita.

Claim 1 has been amended to recite “selecting means for automatically selecting an image signal when said memory control means decides that the photographing is impossible because a remaining amount of said image memory means is smaller than a predetermined value.” Similar amendments also were made to claims 9 and 10. As is clear from the background section of the specification as originally filed, one of the aspects of the invention is to avoid any on-spot user input in selecting and deleting the photographed pictures to increase the memory capacity, because photographers are reluctant to erase photographed images at the photographing spot. This reference to the patent specification is in no way intended to be limiting on the scope of the invention. It is, after all, the claims (and not the specification) that determines the scope of the claimed invention.

This feature is nowhere disclosed in Kinoshita. Kinoshita merely discloses that the content of the frame memory may be transferred at once to increase the memory capacity, but

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Kinoshita fails to teach, disclose or suggest any selecting means/step as recited in claims 1, 9 and 10.

3. Claim 30 Is Not Anticipated By U.S.  
Patent No. 4,827,347 to Bell

Applicant respectfully traverses the rejection, in paragraph 7 of the office action, that claim 30 is allegedly anticipated by Bell.

Claim 30 has been amended for further clarification, and now recites “automatically selecting an image signal on the basis of a predetermined selecting condition from said image memory means when a result of said discrimination indicates that the photographing is impossible.” As discussed above, one of the aspects of the invention is to avoid any on-spot user input in selecting and deleting the photographed pictures to increase the memory capacity because a resistance feeling against the work to erase the photographed images at the photographing spot is strong for the photographer. Again, this reference is not meant to be limiting on the claims.

Bell discloses an electronic camera provided with a plurality of display frame stores and a plurality of selection means (e.g., touch sensitive media) corresponding to the display frame stores. A photographer may select which images from the plurality of displayed images are to be retained by touching the selection means. The selected images may be stored for more permanent storage in a larger addressable memory. A transmitting feature is also provided to unload the selected images from the addressable memory for transmission to a viewer and/or printer.

Bell’s electronic camera needs a user input in the selecting procedure, and fails to teach, disclose or suggest the “automatically selecting” feature of claim 30.

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4. Claim 31 Is Not Anticipated By U.S.  
Patent No. 6,263,106 to Yamagata

Applicant respectfully traverses the rejection, in paragraph 8 of the office action, that claim 31 is allegedly anticipated by Yamagata.

Claim 31 has been amended for further clarification, and now recites “automatically selecting an image signal on the basis of a predetermined selecting condition from said image memory means when a result of said discrimination indicates that the photographing is impossible.” As discussed above, one of the aspects of the invention is to avoid any on-spot user input in selecting and deleting the photographed pictures to increase the memory capacity because a resistance feeling against the work to erase the photographed images at the photographing spot is strong for the photographer. Again, this reference is not meant to be limiting on the claims.

Yamagata discloses an image data compression device in which a selected image is automatically compressed upon detecting the remaining capacity of the memory device. In particular, Yamagata’s device enables a user to select image data that is inhibited from being compressed.

Yamagata’s image data compression device needs a user input in the selecting procedure, and fails to teach, disclose or suggest the “automatically selecting” feature of claim 31.

C. Claims 1-4 and 7-8 Are Patentably Distinct From Hull,  
Kinoshita, Takiyama And Sono, Alone Or In Combination

Finally, Applicant respectfully traverses the rejections, in paragraphs 10-12 of the office action, that claims 1-4 and 7-8 are allegedly unpatentable over Hull in view of Kinoshita

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and optionally further in view of Takiyama and Sono. Independent claim 1 recites, inter alia “selecting means for automatically selecting an image signal when said memory control means decides that the photographing is impossible because a remaining amount of said image memory means is smaller than a predetermined value”.

The Office Action indicates that Hull discloses each and every element of independent claim 1 except the “automatically transmitting” feature. The Office Action argues that this feature is well known as disclosed in Kinoshita.

Hull discloses a portable image capture system in which a user captures the image and, if image memory is full, transmits images back to server station enabling the user to take as many pictures as desired without worrying about running out of film or image memory capacity. Hull also discloses that the image capture system is configured to communicate with a cellular telephone network.

Hull, however, discloses that:

When the user decides to free up additional memory by transmitting images already stored in image memory 24, the user initiates a command sequence using command input device 32. (col. 3, lines 18-22 of Hull)

Thus, Hull’s image capture system also requires a on-spot user input to free up the memory capacity as in Kinoshita’s device. Accordingly, Hull and Kinoshita, either alone or in combination, fail to teach, disclose or suggest the “selecting means” of claim 1.

Takiyama is cited as disclosing that the photographing times of the image signals stored in the memory is used to manage the stored image data. Takiyama discloses a image

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processing data in which image data are transferred between memories. We note that a portion of Takiyama reads:

The region indicating unit 2 further looks up the region management table 3 to judge the image storing region that stored the image data most previously and already digitized to read out.

The storage device 4 records the image data read out by the region indicating unit 2 into a predetermined media. (col. 3, lines 51-57 of Takiyama)

The cited portions above may be interpreted to read the “selecting means for automatically selecting” element in claim 1. However, claim 1 as amended further requires that “selecting means for automatically selecting an image signal when a photographing is impossible because a remaining amount of said image memory means is smaller than a predetermined value.” We believe that Takiyama fails to teach, disclose or suggest at least the “selecting means” feature of claim 1. Sono is cited as disclosing managing means for managing accessing frequencies of the stored image signal. Sono, however, failing to show or suggest the features of claim 1 (i.e., “selecting means”) from which claim 4 depends, does not render claim 4 obvious.

Accordingly, dependent claims 2-4 and 7-8, in depending from independent claim 1, are not anticipated by nor rendered obvious over the cited references (i.e., Hull, Kinoshita, Takiyama and Sono).

We have not individually addressed the rejections of the dependent claims because we believe that the foregoing places the independent claims from which they respectively depend in condition for allowance. We however will reserve the right to address such rejections of the dependent claims should such be necessary.

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### CONCLUSION

For the above-stated reasons, this application is respectfully asserted to be in condition for allowance. An early and favorable examination on the merits is requested. In the event that a telephone conference would facilitate the examination of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY ADDITIONAL FEES WHICH MAY BE REQUIRED FOR THE TIMELY CONSIDERATION OF THIS AMENDMENT UNDER 37 C.F.R. §§ 1.16 AND 1.17, OR CREDIT ANY OVERPAYMENT TO DEPOSIT ACCOUNT NO. 13-4500, ORDER NO. 1232-4440.

Respectfully submitted,  
MORGAN & FINNEGAN, L.L.P.

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By:



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